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REMARKS

Claims 1-22 and 28-33 are currently pending in the subject application and are presently under consideration. Claims 1-5, 7, 9, 12-13, 22, 29 and 31 have been amended herein to cure minor informalities, and the second occurrence of claim 30 has been renumbered in accordance with the Examiner's recommendation. A version of all pending claims is found at pages 2-6. Favorable consideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Claim Objections Under 37 C.F.R. §1.126

The Examiner asserts that the claims are not numbered in accordance with 37 C.F.R. §1.126. Withdrawal of this objection is requested in view of the renumbering of the claims by applicants' representative.

II. Rejection of Claims 1-22 and 28-33 Under 35 U.S.C. §112

Claims 1-22 and 28-33 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Withdrawal of this rejection is requested for at least the following reasons. Claims 1-22 and 28-33 are definite and distinctly claim the subject matter that applicants regard as the invention.

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916), which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that *any person skilled in the art can make and use the invention without undue experimentation*. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). ... *A patent need not teach, and preferably omits, what is well known in the art*. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). (See MPEP §2164.01) (emphasis added).

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The Examiner contends that the recitation of limitations involving "a SLANG programming language" in independent claims 1, 7 and 28 are not defined in the specification in a manner necessary to define the ascertainable scope for the claims. Applicants' representative avers to the contrary. The specification at page 18, line 17 states: "The model of the present invention can be reduced to a programming language." Further, the specification at page 18, lines 17-21 provides that the present invention is illustrated utilizing "a scheduling programming language written in XML (hereinafter referred to as SLANG) including syntax that allows for expression of features associated with the model of the present invention." Moreover, page 18, lines 27-29 disclose, "that the present invention can apply to a variety of application programming languages and is not specifically limited to a scheduling language." It would therefore be clear to an ordinary artisan skilled in the art that any application programming language could be utilized to reduce a business model, and that the SLANG programming language explicated in the subject specification is an illustrative example of how this may be accomplished.

Additionally, figures 6-30, and the commentary associated therewith, and the appendix on pages 27-29 elucidating a document type definition, provide an abundance of examples and context sufficient to enable one ordinarily skilled in the art to practice the invention without undue experimentation. In particular, figures 6-30 and the appendix apprise the reader of the grammar, constructs and syntax necessary to practice the invention as claimed both in Extended Backus-Naur Form (EBNF) as well as in an expository XML scheduling language (SLANG programming language). More particularly, figure 6 provides an example of SLANG programming grammar as well as constructs and syntax in EBNF to reduce a business transaction model that is applicable to any application programming language. It is thus submitted that a person of ordinary skill in the art on reviewing the EBNF constructs depicted in figure 6 would be able to utilize the grammar represented therein and apply the constructs and syntax to facilitate reduction of a business model to any application language that they choose.

Moreover, figures 7-30 provide further elucidation through EBNF, the exemplary SLANG programming language, and by way of example illustrating the utilization of the particular EBNF constructs and the SLANG programming language depicted in figure 6

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to facilitate the reduction of the business model to an application language of choice.

In addition, the Examiner asserts:

[w]hile the Extended Backus-Naur Form illustrated in Fig. 6 may be capable of formally defining such a SLANG programming language (a Backus-Naur form is a well know metalanguage tool for formally defining the syntax of a language), the specification falls short of limiting it to such, and accordingly, the metes and bounds of "a SLANG programming language" are not properly defined. (See Office Action, page 4).

Applicants' representative contends to the contrary. It is well-established principle that the specification does not provide the metes and bounds of a particular claimed invention, but rather, it is the claims that define the purview of the invention that an applicant believes is patentable. (See e.g., *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057, 1058 (Fed. Cir. 1993). Thus, it is only the language of the claims that describe and point out the invention (See e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989), and not the specification that circumscribes the claims. Additionally, it is well recognized that claims may be broader than the specific embodiment disclosed in the specification. (See e.g., *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985). In the Office Action, the Examiner in effect admits that the Extended Backus-Naur Form depicted in Fig. 6 may be capable of formally defining a SLANG programming language. Accordingly it is submitted that the Extended Backus-Naur Form definition of the SLANG programming language provides a closed universe sufficient to enable one skilled in the art, upon perusing the specification, to recognize the limits of applicants' claimed invention as recited in the claims. Therefore it is submitted that the Examiner's assertion that the specification falls short of limiting the claims, and in particular fails to provide the metes and bounds of a SLANG programming language, are clearly in error.

In view of at least the foregoing, it is requested that the rejection of claims 1, 7 and 28 (and claims that depend there from) should be withdrawn.

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III. Rejection of Claims 1-14, 21-22 and 28 Under 35 U.S.C. §103(a)

Claims 1-14, 21-22 and 28 stand rejected under 35 U.S.C. §103(a) as being obvious over Release 8.0 of the Workflow Template software product publicly available from Template Software, Inc. in 1998 as evidenced by "Using the WFT Development Environment", 1998 (hereinafter Template) in view of Ambler *et al.* (US 6,393,456). Withdrawal of this rejection is requested for at least the following reasons. The combination of Template and Ambler *et al.* does not teach or suggest all limitations set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Applicants' claimed invention relates to a system and method for modeling a business workflow process that employs process algebra techniques to arrive at a model. Independent claims 1, 7 and 28 recite a similar limitation, namely: *reducing a business process to a SLANG programming language*. Neither Template nor Ambler *et al.* teach or suggest this novel aspect of applicants' claimed invention.

Template discloses a Workflow Design Editor (WDE) that enables one to design a workflow system at a high level. The Examiner contends that Template provides reducing a business process utilizing a SLANG programming language at page 3-2, and in particular the first paragraph of the "Introduction" section. Applicants' representative avers to the contrary. The indicated passage, and specifically the first paragraph of the

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Introduction, fails to provide the reduction of a business process to a SLANG programming language as recited in the subject claims. Rather, it would appear that the noted passage provides for the manipulation of graphical representations of a workflow system that comprises tasks, flows, work items, roles, junctions and labels. The invention as claimed on the other hand reduces a business process to a programming language that is definable by specified grammar comprising particular constructs and syntax. Nowhere in Template is there mention of the reduction of a business process to a set of irreducible constructs/elements, wherein the irreducible elements can effectively comprise a programming language. Thus, it is submitted that Template, contrary to the Examiner's assertions, fails to provide this particular novel aspect of the subject claims.

In addition, independent claims 1, 7 and 28 recite: *dividing the reduced business process into at least one independent transaction and at least one parent interdependent transaction, the at least one parent interdependent transaction comprises two or more child interdependent transactions*. The Examiner asserts that these particular elements can be found at page 3-20, Fig. 3-3 on page 3-12, and page 3-19 of Template. Applicants' representative contends that the Examiner has mischaracterized the cited document. As stated *supra*, the cited document fails to reduce a business process into a set of programming language constructs, consequently it is asserted that it is implausible for the Examiner to contend that Template can possibly be *dividing the reduced business process* since such a reduction is neither taught nor suggested within the cited document.

Nevertheless, if *arguendo* the cited document did, as the Examiner claims, reduce a business process to a programming language, Template is deficient in failing to disclose dividing the reduced business process into *at least one independent transaction and at least one interdependent parent transaction wherein the at least one interdependent parent transaction comprises two or more child interdependent transactions*. While applicants' representative is cognizant that the cited document provides, at pages 3-19 and 3-20, for joining two or more flows into a single flow through the creation of a compound flow, and splitting a flow into two or more flows through the creation of a copy flow, the cited document is nevertheless silent with regard to whether the splitting and combining of the flow constitutes dividing or combining the flow based on whether

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or not transactions are independent of one another or whether a interdependency exists between particular transactions. It would appear therefore that Template does not distinguish between independent transactions *per se* and transactions that are interdependent on one another, *i.e.*, the cited document is incapable of discerning the distinction between transactions that comprise two or more child interdependent transactions (interdependent parent transactions) and transactions that have no dependencies whatsoever (independent transactions).

Further, independent claim 1 specifically recites: ***executing the child interdependent transactions independently from each other, the at least one parent interdependent transaction commits when the last child interdependent transaction commits***. The Examiner however has failed to address this particular claim aspect. Nevertheless, for the reasons stated above, applicants' representative asserts that Template does not teach or suggest this novel aspect of the subject claim since the cited document fails to even tacitly make a distinction between independent transactions and interdependent transactions. It is further asserted that because Template fails to discern the distinction between independent transactions and interdependent transactions, that the cited document cannot possibly categorize transactions into independent transactions and interdependent parent transactions so as to execute child interdependent transactions in such a manner that the interdependent parent waits for the last of its child interdependent transactions to commit.

Moreover, the Examiner concedes that Template does not disclose the programming language having a XML syntax. In order to rectify this deficiency the Examiner offers Ambler *et al.* col. 8, lines 42-46 and col. 12, lines 49-59. Ambler *et al.* however is not a citable reference with respect to the subject application. The following is a quotation of 35 U.S.C. §103(c), which forms at least one basis for withdrawal of all rejections in this Office Action:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject

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to an obligation of assignment to the same person.

It is respectfully submitted that Ambler *et al.* qualifies as art under 35 U.S.C. §102(e), and the subject matter of Ambler *et al.* and the claimed invention were under an obligation of assignment to Microsoft Corporation at the time the invention was made. Therefore, in accordance with 35 U.S.C. §103(c), Ambler *et al.* is not a citable reference with respect to the subject application. Accordingly, this rejection should be withdrawn with respect to independent claims 1, 7, 28 (and claims that depend there from).

IV. Rejection of Claims 15-20 and 29-33 Under 35 U.S.C. §103(a)

Claims 15-20 and 29-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Template in view of Ambler *et al.* as applied to claims 1 and 12 above, and further in view of Chen *et al.* (US 5,940,839). This rejection should be withdrawn for at least the following reasons. Claims 15-20 and 29-33 depend from independent claims 1 and 7; and Ambler *et al.* and Chen *et al.* do not cure the aforementioned deficiencies with respect to the limitations recited in claims 1 and 7. Further, as noted above, Ambler *et al.* is not a citable reference with respect to the subject application. Accordingly, this rejection should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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